

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated April 9, 2004.

Applicant has noted the objection to the drawings in paragraph 3 of the Office Action and has amended the specification in a manner which is believed and submitted to render that objection moot. Withdrawal thereof is respectfully requested.

Similarly, with respect to the rejection of claim 12, as noted in paragraphs 4 and 5 of the Office Action, the applicant has rendered the objection moot through the cancellation without prejudice of the claim.

Applicant has further noted the rejection of claims 1-7 under 35 U.S.C. §112, second paragraph, and has amended the claims in a manner which is believed and respectfully submitted to clearly avoid the same. Withdrawal thereof is earnestly solicited.

Substantively, claims 1, 4, 6, 8 and 10-12 stand rejected on grounds of anticipation by Morikawa (6,388,551) and claims 2 and 3 are stated to be unpatentable on grounds of obviousness over Morikawa, in view of Uriu (6,293,001). Further, claim 5 is stated to be obvious over Morikawa, in view of Matsuta (6,710,694), claim 7 is stated to obvious over Morikawa, and claim 9 is stated to be obvious over Morikawa in view of Chazono (6,362,947).

Reconsideration of the above-noted rejections on prior art is requested in view of the amendments to the claims herein and the following remarks.

Claim 1 defines a stacked coil device which has an inner electrode that comprises a one layer construction, that includes a non-magnetic electrode region and a magnetic region. The non-magnetic region has an opening at a center thereof and also has an electrode pattern. The magnetic region of the inner electrode includes one portion which is positioned at the opening (of the non-magnetic region) and portions that are located "at lateral sides of the non-magnetic electrode region".

Without intending to limit the scope of claim 1 to Figures 3E and 3F, these figures are nevertheless useful to allow the Examiner to appreciate the subject matter being claimed in claim 1. That is, the pieces designated 39 in Figure 3F and the pieces that constitute the elements 38a and 38b in 3E fit together, similarly to a puzzle, and as such, form a single layer atop the base 32.

Turning to the references, Morikawa teaches laminated dielectric sheets for a balun transformer. The laminated structure of dielectric sheets are similar to those shown in the conventional art described in the present specification. Since the electrode patterns on the respective

dielectric sheets are interrupted by an intervening dielectric layer, they are susceptible to magnetic leakage. More importantly, Morikawa does not disclose a single layer formed with two different regions, one a magnetic region and the other a non-magnetic region, with an electrode pattern formed on the non-magnetic region. Moreover, Morikawa does not teach or suggest the manufacturing method of the claimed invention.

The foregoing remarks alone are sufficient to clearly distinguish all of the claims in the application over the prior art cited thereagainst.

For completeness, applicant also points out that Uriu discloses a similar laminated structure, which essentially corresponds to the one disclosed in Morikawa. An intervening dielectric layer interrupts electrode patterns. As such, this reference teaches a construction that is susceptible to magnetic leakage.

Matsuta shows a laminated structure comprising a dielectric layer and a magnetic layer. Once again, these layers do not form and are not provided as one layer.

In summary, none of the cited references shows a single layer with a non-magnetic electric region and a magnetic region, wherein the non-magnetic electrode region also has an opening at its center and an electrode pattern as claimed in claim 1. Further, none of these references show a magnetic region at the opening and at the lateral sides of the non-magnetic electrode region. Thus, the prior art, whether taken singly or in any combination or permutation, does not anticipate or suggest the claimed invention. Therefore, claims 1 and 8, and their dependent claims, merit to be promptly allowed.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

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Name of applicant, assignee or
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July 7, 2004

Date of Signature

Respectfully submitted,

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